

In re PULLELA ET AL., Application No. 10/625,063
Amendment A

REMARKS

The Office action dated September 1, 2005, and the references cited have been fully considered. In response, please enter the amendments presented herein and consider the following remarks. Reconsideration and/or further prosecution of the application is respectfully requested. No new matter is added herein.

Applicants appreciate the Office detecting the typographical error in the numbering of the claims. Claim 18 is marked herein as canceled, and therefore the claim numbering complies with Rule 126, which requires the numbering of claims to remain the same throughout prosecution.

In terms of the other amendments to the claims, claims 2, 10, 12, and 20 are not changed but merely re-written in independent form, with their respective independent claims canceled, and the other dependent claims amended to change their dependency so that they depend from a pending claim.

As to the claim rejections, in terms of the § 101 rejection, the specification is amended herein to clarify the description of computer-readable medium in accordance with the MPEP. No new matter is added with this amendment. Applicants therefore request the § 101 rejections be withdrawn.

In regards to pending independent claims 2, 10, 12, and 20 (merely original dependent claims rewritten in independent form), Applicants respectfully submit that the prior art of record neither teaches nor suggests all the recited limitations; and therefore, are allowable, and Applicants respectfully request the withdrawal of all rejections based on prior art as all claims depend from one of these allowable independent forms. As each of independent claims 2, 10, 12, and 20 recite similar elements/limitations, Applicants will address claim 1 with these remarks applicable to these other claims.

It is well-established law that the burden is on the Office to initially present a *prima facie* unpatentability (e.g., anticipation, obvious) rejection, before Applicant has any burden of proof of disproving any application of a cited reference against a claim. *In re Warner*, 379 F.2d 1011,

In re PULLELA ET AL., Application No. 10/625,063
Amendment A

1016, 154 USPA 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986). The MPEP and law is clear that for anticipation, the reference *must teach each and every aspect of the claimed invention* either explicitly or impliedly, and the burden is on the Office to present a *prima facie* case of anticipation. MPEP § 706.02. Inherent means it *must* occur. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112 (*emphasis in original*). Moreover, obviousness under 35 USC § 103(a) requires "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 706.02(j) (*citing In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991))(*emphasis added*). Applicants respectfully submit that for at least original claims 19-27, such an initial showing has not been done.

Claim 2 recites, *inter alia*, "masking the flow identification value with the flow identification value mask to generate a masked flow identification value," with the elements of the flow identification value with the flow identification value mask previously introduced in the claim (i.e., this previous introduction provides the antecedent basis for these elements). The Office action equates Ikeda et al.'s VPI/VCI indication as the recited limitation of "the flow identification value" and equates Ikeda et al.'s retrieval flag as the recited limitation of "the flow identification value mask." Therefore, a *prima facie* anticipation rejection would need to teach that Ikeda et al.'s VPI/VCI indication is masked with Ikeda et al.'s retrieval flag, which is not done. Moreover, even Ikeda et al.'s masking of the flow retrieval key 25 with retrieval flag 24 neither teaches nor suggest such a configuration, as it fails to mask Ikeda et al.'s VPI/VCI. In fact, the operation of Ikeda et al. operates much differently than recited in the claims as Ikeda et al.'s retrieval flag 24 is retrieved based on the VPI/VCI of an ATM cell; while Ikeda et al.'s flow retrieval key (25) is extracted from the header of an IP packet and not of the header of the ATM cell. For at least these reasons, the prior art of record neither teaches nor suggests all the recited claims elements/limitations of a pending claims, and therefore, Applicants respectfully request

In re PULLELA ET AL., Application No. 10/625,063
Amendment A

all the claim rejections be withdrawn. Also, as the Office action did not establish a proper *prima facie* rejection of any claim, Applicants have no burden to discuss any other claim limitation or claim.

For at least the reasons presented herein, all claims are patentably distinct from the prior art references cited in the Office action. If the Examiner complies with MPEP § 706 and 37 CFR 1.104(c)(2), then the Examiner cited the best prior art references available. As the prior art of record neither teaches nor suggests all the claim limitations of any pending claim, then all pending claims are believed to be allowable over the best prior art available, and Applicants request the claims be allowed and the application pass to issuance.

Final Remarks. Applicants hereby petitions/requests a one-month extension of time, with payment for such extension of time provided by the enclosed credit card payment form (PTO-2038). Should a different extension of time be deemed appropriate, Applicants hereby petition for such deemed extension of time. Applicants further authorize the charging of Deposit Account No. 501430 for any fees that may be due in connection with this paper (e.g., claim fees, extension of time fees).

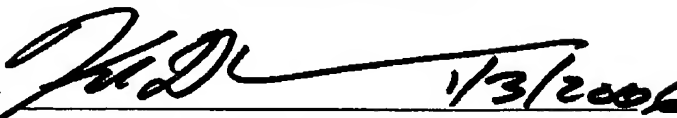
In view of the above remarks and for at least the reasons presented herein, all pending claims are believed to be allowable over all prior art of record, the application is considered in good and proper form for allowance, and the Office is respectfully requested to issue a timely Notice of allowance in this case. Applicant requests any and all rejections and/or objections be withdrawn. If, in the opinion of the Office, a telephone conference would expedite the prosecution of the subject application, the Office is invited to call the undersigned attorney, as Applicants are open to discussing, considering, and resolving issues.

In re PULLELA ET AL., Application No. 10/625,063
Amendment A

Respectfully submitted,
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By



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